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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,519	11/06/2003	Hugh C. Gardner	019662/310960	7372
826	7590	10/03/2006		EXAMINER
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000				JUSKA, CHERYL ANN
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/701,519	GARDNER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Cheryl Juska	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 20 July 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.                                                         | 6) <input type="checkbox"/> Other: _____.                         |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

### ***Response to Amendment***

2. Applicant's amendment filed July 20, 2006, has been entered. Claim 1 has been amended as requested. The pending claims are 1-6.
3. Said amendment is sufficient to withdraw the 112, 2<sup>nd</sup> rejection set forth in section 5 of the last Office Action.

### ***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-6 stand rejected under 35 USC 103(a) as being obvious over US 6,060,145 issued to Smith et al. as set forth in section 7 of the last Office Action.

Applicant has amended the claim to narrow the transitional phrase from "comprising" to "consisting of." While the transitional phrase "consisting of" limits a component to only

containing the elements explicitly recited, applicant's assertion that said amendment is sufficient to overcome the Smith rejection is incorrect. Specifically, the claim recites "a secondary carpet backing consisting of a single layer of woven fabric...." However, as noted in the Advisory Action of July 12, 2006, the claims are drawn to an intermediate product of "a secondary carpet backing" rather than a final product of a carpet containing a secondary carpet backing. As such, the limitation of "secondary carpet backing" is merely descriptive of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Additionally, said recitation to "a secondary carpet backing" is a preamble limitation that is not given patentable weight at this time. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Hence, for the purposes of examination, the recitation to "a secondary carpet backing" is not given patentable weight and the claims are, in effect, drawn to "a single layer of a woven fabric" that is capable of acting as a secondary carpet backing. This does not exclude, however, a carpet comprising a secondary backing having the recited woven fabric and another layer. In other words, a woven fabric having the claimed weave construction, whether it be an

intermediate or final product, would read on the present claim. A plain weave fabric inherently is a “single layer.”

Furthermore, as previously argued, Smith employs a “conventional secondary backing” (i.e., the plain weave fabric) for the base of its inventive modified secondary backing. This suggests to one that secondary backings of the claimed plain weave construction were “conventional” in the art or known prior to the Smith ‘145 invention. Therefore, the rejection of claims 1-6 stands as set forth in previous Office Actions.

#### *Response to Arguments*

6. Applicant's arguments filed with the amendment have been fully considered but they are not persuasive.

7. Applicant traverses that the “conventional secondary backing” of Smith (scrim fabric 15) is an open weave construction with a very high air permeability. In response, it is noted that applicant does not recite an upper limit to the claimed air permeability. As such, the present claims do not exclude Smith’s “very high air permeability” nor does Smith teach away from the claimed invention.

8. Additionally, applicant argues that Smith employs a leno weave fabric of 16 ends/in and 5 picks/in, while applicant employs a flat, plain weave fabric of 10-20 picks/in and a desired warp coverage. In response, it is noted that the said leno weave of Smith is a preferred embodiment. The reference teaches other fabrics, including plain weave fabrics, with different warp and weft counts are suitable for the invention. Also, note that the rejection is not a 102

anticipation rejection, but a 103 obviousness rejection. Specifically, it would have been obvious based upon the teachings of Smith to select a fabric as presently claimed.

9. Applicant asserts that the specification shows that a fabric similar to the 16 x 5 leno weave of Smith does not have the claimed warp coverage. In response, it is reiterated that the Smith invention is not limited to the one embodiment of a 16 x 5 leno weave.

10. Applicant continues to argue that Table 2 of specification teaches other “commercial secondary backings” that do not possess the warp coverage and air permeability of the present invention. Also applicant reiterates the argument of unexpected results shown by the Gardner Declaration filed on November 1, 2005. However, as noted in section 10 of the Final Rejection mailed January 20, 2006, said Declaration is insufficient to show unexpected results of the claimed invention over the teachings of the Smith ‘145 reference. Applicant still has not shown unexpected results are achieved from optimizing the result effective variables such as yarn denier or width, basis weight, and/or yarn count and the above rejection over Smith stands.

### *Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1771

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CHEERYL A. JUSKA  
PRIMARY EXAMINER

cj

September 27, 2006